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OFFICE OF PETITIONS

In re Application of
Abdallah et al. :
Application No. 09/053,006 : **ON PETITION**
Filed: 31 March, 1998 :
Attorney Docket No. 042390.P4918 :

This is a response to the renewed petition styled under 37 CFR 1.181, filed on 6 September, 2001, which is treated as a petition under 37 CFR 1.53 that (a) the papers filed on 5 April, 2000, be treated as a Continued Prosecution Application and (b) the holding of abandonment be withdrawn.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is again **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency action.

This application became abandoned on 19 April, 2000, for failure to timely submit the issue fee as required by the Notice of Allowance mailed on 18 January, 2000, which set a three (3) month statutory period for reply. On 5 April, 2000, a preliminary amendment and an application transmittal letter and fee were filed. A Notice of Abandonment was mailed on 26 July, 2000. The

petition to withdraw the holding of abandonment mailed on 14 August, 2000, was dismissed on 10 August, 2001.

Petitioners assert that a Continued Prosecution Application was timely filed on 5 April, 2000. In support of the petition, petitioners have submitted of a postcard itemizing the filing of an application under 37 CFR 1.53(d) and identifying the above-identified application number and its filing date, attorney docket number, invention title, and first named inventor's last name and containing an "Office-date" stamp of 5 April, 2000. It is noted that the petition filed on 14 August, 2000, was also accompanied by a copy of a check for \$690.00, and that on 28 November, 2000, petitioners provided a copy of an application transmittal sheet allegedly filed as the CPA request on 5 April, 2000. Petitioners assert that the submission on 5 April, 2000, should be treated as a CPA.

Petitioners' assertion has been carefully considered, but is not considered persuasive. Although petitioner's postcard itemized the filing of an application under 37 CFR 1.53(d), petitioners have not provided a copy of an application under 37 CFR 1.53(d) filed on 5 April, 2000. A review of the application file reveals that a preliminary amendment and application transmittal sheet filed on 5 April, 2000, are located therein. Furthermore, a careful examination of the application transmittal sheet reveals that it does not request a CPA, or any continuing application.

37 CFR 1.53(d) states, in pertinent part:

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed a continued prosecution application under this paragraph, provided that:

(i) the prior nonprovisional application is either:

...

(C) The national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371; and

(ii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

...

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes.; and\

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

Section 201.06(d) of the Manual of Patent Examining Procedure (MPEP) states, in pertinent part:

If application papers are in any way designated as a CPA filing under 37 CFR 1.53(d) (e.g., contain a reference to 37 CFR 1.53(d), CPA, or continued prosecution application), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even though the application papers also contain other inconsistent designations (e.g., the papers are also designated as an application filed under 37 CFR 1.53(b)).

The showing of record, is that a utility patent application transmittal letter, a preliminary amendment, and an application fee were filed on 5 April, 2000. The papers filed on 5 April, 2000, do not request a CPA, reference an application under 37 CFR 1.53(d), or contain a request to expressly abandon the prior application. Simply put, the papers received on 5 April, 2000,

do not evidence an intent to file a CPA. In this regard, it is noted that neither the application transmittal sheet nor the preliminary amendment request a CPA, nor any continuing application. The Office cannot construe the filing of a preliminary amendment, an application transmittal letter, and an application fee, without more, as a request for a CPA. While petitioners may have intended to file a CPA, the papers, when viewed objectively, lack sufficient indications that a CPA was filed. As such, petitioners have not provided evidence that a CPA was actually filed on 5 April, 2000.

Petitioners are reminded that CPA practice was eliminated on 14 July, 2003.¹ As such, the Office can no longer accept an application filed under 37 CFR 1.53(d). Applicants may therefore wish to consider filing a Request for Continued Examination (RCE) designating the amendment filed on 5 April, 2000, as the submission required by 37 CFR 1.114 and pay the fee required for filing an RCE. To continue examination of the present application, petitioners would also be required to revive the present application, including payment of the issue fee.

Petitioner is advised that any issue fee paid in the present application cannot be refunded. However, if the application is allowed again, petitioner may request that the \$1,330.00 be applied towards the issue fee required by the new Notice of Allowance.²

The Office acknowledges receipt of \$690.00 on 5 April, 2000. Petitioners may request that the \$690.00 paid on 5 April, 2000, be applied towards the fee for filing an RCE and pay the balance due for the RCE fee.

The application file will be retained in the Office of Petitions for TWO (2) MONTHS to await petitioner's response thereto. If a reply is not received within that period, the file will be forwarded to Files Repository as an abandoned application.

¹1271 O.G. 143, 68 Fed. Reg. 32376 (May 30, 2003).

²The request to apply the issue fee to the new Notice of Allowance must be made in writing and should be accompanied by the new Issue Fee Transmittal Form (PTOL-85(b)), along with a copy of this decision. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due at the time of payment must be submitted. **Failure to timely request in writing that the previously paid issue fee be applied towards the new Notice of Allowance and payment of any balance due will result in the abandonment of the application.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



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